REMARKS

In the Office Action, the Examiner indicated that he has withdrawn the restriction requirement. Further, the Examiner has indicated that claims 47-61 are allowed and that claims 2-9, 11-13, 16, 18-20, 25-46, 31A, 31B, and 62-73 recite allowable subject matter. Applicants wish to thank the Examiner for this early indication of allowable subject matter.

Also in the Office Action, the Examiner objected to the numbering of claims 31A and 31B and has asked that all occurrences of "antennae" be changed to "antennas." The Examiner also rejected claims 26-46 and 62-73 under 35 U.S.C. §112, second paragraph, and rejected claims 1, 10, 14, 15, 17, and 21-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,313,783 issued to Kuntman et al.

By this Amendment, Applicants have amended the specification to correct typographical errors; canceled claims 31A and 31B without prejudice; amended claims 1, 2, 5-8, 10, 14, 16, 17, 19-21, 23, 24, 26, 27, 31-34, 36, 40, 42, 43, 45-47, 49-52, 55, 62, 64, 65, 67-69 and 71-73 to more clearly define the present invention; and added new claims 74 and 75 corresponding to prior claims 31A and 31B, respectively. Applicants submit that no new matter has been added by this Amendment.

With respect to the claim objections, Applicants have canceled claims 31A and 31B without prejudice and represented these claims as claims 74 and 75, respectively, as suggested by the Examiner. In addition, the specification and claims have been amended to change all occurrences of "antennae" to "antennas," as also suggested by the Examiner.

With respect to the rejection of claims 26-46 and 62-73 under 35 U.S.C. §112, second paragraph, Applicants have amended claims 26, 62, 65, and 69 as suggested by the Examiner. Accordingly, Applicants submit that claims 26-46 and 62-73 meet the requirements of 35 U.S.C. §112, second paragraph.

Applicants respectfully traverse the rejection of claims 1, 10, 14, 15, 17, and 21-24 as being obvious over Kuntman et al.

In the Office Action, the Examiner contends that Kuntman et al. teaches a vehicle having first and second directional antennas and a receiver. The Examiner correctly admits that Kuntman et al. does not disclose that the directional antennas are placed on an exterior mirror of

the vehicle. However, the Examiner contends "[a]s long as the system is [sic] function the same, having the antenna system mounted on any location would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the antenna system of Kuntman et al. mounted on any location as desired, such as the external mirror of the vehicle, in Kuntman et al. for performing the same function for obvious design choice." Applicants respectfully disagree with this position as discussed further below.

The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

> The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Kuntman et al. does not suggest the desirability of mounting the antennas in an exterior mirror of a vehicle. The alleged desirability to so locate the antennas does not come from the prior art, but rather comes from Applicants' own application. Accordingly, it is clear that impermissible hindsight has been utilized in the obviousness analysis.

Further, Kuntman et al. discloses a system for an airplane to communicate with Air Traffic Control. To the undersigned's knowledge, airplanes do not have exterior mirrors. Therefore, one skilled in the art would clearly not have been motivated to locate the antennas in

Kuntman et al. in such a non-existent external mirror. Thus, the Examiner must first show that airplanes having exterior mirrors were known in the prior art. I f the Examiner is aware of any prior art references that disclose airplanes having exterior mirrors, Applicants ask the Examiner to cite such a reference. Even if such an airplane were known, however, Applicants submit that it would not have been obvious to locate the antennas in such exterior mirrors for the reasons stated in the preceding paragraph.

For the reasons stated above, Applicants submit that a prima facie case of obviousness has not been established with respect to claims 1, 10, 14, 15, 17, and 21-24.

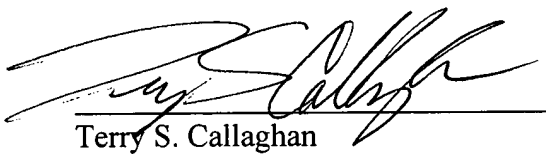
In view of the foregoing amendments and remarks, Applicants submit that the present invention as defined by the pending claims is allowable over the prior art of record. The Examiner's reconsideration and timely allowance o f the claims is requested. A Notice of Allowance is therefore respectfully solicited.

Respectfully submitted,

ROBERT C. KNAPP ET AL.

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP

7-21-2004
Date



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